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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/723,441	11/25/2003	Gary D. Garrett	50612/WPC/B317	5992
23363	7590	06/27/2005	EXAMINER	
CHRISTIE, PARKER & HALE, LLP			WARREN, DAVID S	
PO BOX 7068			ART UNIT	
PASADENA, CA 91109-7068			PAPER NUMBER	
			2837	

DATE MAILED: 06/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

AK

Office Action Summary

Application No.

10/723,441

Applicant(s)

GARRETT ET AL.

Examiner

David S. Warren

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 2, and 10 – 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Kennedy (5,027,691). Regarding claims 1, 10, and 11, Kennedy discloses the use of a pickup system comprising a primary coil (29) magnetically coupled to a string and fixedly attached to a string support structure (15), and a secondary coil (21) magnetically coupled to the primary coil (29) wherein the secondary coil is flexibly connected to the primary coil. The Examiner maintains that while the Applicant's structure may differ slightly from that of Kennedy, the relative movement (i.e., by a flexible connection) of coil 21 to pickup assembly 29 and 32 is functionally equivalent to that of the Applicant. Where the Applicant uses a coil to sense relative movement, Kennedy uses a moving coil to sense relative movement, i.e., functionally equivalent systems. Regarding claim 2, Kennedy discloses a humbucking relation between coils (see Kennedy's claim 2). Regarding claims 12 and 13, Kennedy discloses the use of a plastic suspension mount 30 (i.e., a "pillar") connected to 25 and ultimately secondary coil 21 – the element 30 appears to be co-extensive to 21, thus "substantially" centered.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 3 – 9 and 14 – 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kennedy in view of Ikuma (4,501,186). The teachings of Kennedy have been discussed supra. Regarding claim 3 (as best as can be understood, see §112 rejection supra), providing humbucking coils with coil winding orientation is well-known (Official Notice is hereby taken). Regarding claims 4 – 6 and 14, Kennedy does not disclose the use of securing the pickup to a soundboard having a sound hole or within a recess of the soundboard. Ikuma discloses mounting a two-pickup system within the recess of a soundboard. It would have been obvious to one of ordinary skill in the art to combine the teachings of Kennedy and Ikuma to obtain a two pickup system, wherein a first transducer senses a second transducer and wherein the system is located within a soundboard recess. The motivation for making this combination is that most acoustic guitars have a soundboard and sound hole, mounting the pickup within the sound hole provides both proximity to the strings and easy-to-mount capability. Regarding the limitations in claims 7 – 9 and 15 – 17, the choice of resonant frequency, spring constant, coil mass, are deemed to be mere matters of design choice and chosen for optimizing operation. It has been held that where

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the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

Double Patenting

5. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

6. Claims 1 – 23 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 15 - 37 of copending Application No. 10/735248. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Allowable Subject Matter

7. Claims 18 – 23 are allowable providing the Applicant cancels the corresponding claims from application serial number 10/735248.

8. The following is a statement of reasons for the indication of allowable subject matter:

The prior art does not disclose the use of a secondary "humbucker" pickup in flexible connection with a primary humbucker pickup.

Conclusion

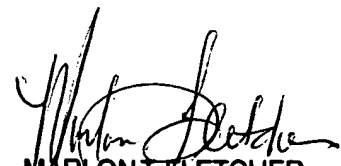
9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The patents to Fender ('975 and '974) and Anderson ('117) disclose pickups having flexible connections. The patents to Barnard ('086) and McCoy ('460) show the use of optoelectronic pickups for stringed instruments.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David S. Warren whose telephone number is 571-272-2076. The examiner can normally be reached on M-F, 9:30 A.M. to 6:30 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Martin can be reached on 571-272-2800 ext 37. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

dsw


MARLON T. FLETCHER
PRIMARY EXAMINER